

PATENT
Attorney Docket No. 204920

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ross et al.

Art Unit: 2164

Application No. 09/100,100

Examiner: P. Kanof

Filed: 06/19/98

For: **MEDICAL RECORDS,
DOCUMENTATION, TRACKING
AND ORDER ENTRY SYSTEM**

**DECLARATION OF DR. JAMES ROSS IN SUPPORT OF
A SUPPLEMENTARY INFORMATION DISCLOSURE STATEMENT**

I, the undersigned, hereby declare the following:

1. I am one of the named inventors of the above-captioned patent application.
2. I have personal knowledge regarding circumstances and facts concerning efforts to obtain the consent of a hospital administrator to volunteer a hospital emergency room as a test site for a software system (TeleMed) that, when completed, would embody the claimed invention. Prior to one year before the priority date of the parent application filed on July 8, 1996, all demonstrations of the Telemed system software were performed under terms of confidentiality.
3. My endeavors to obtain a test site included, in the latter part of 1994, occupying a booth at the American College of Emergency Physicians (ACEP) Scientific Assembly for the purpose of demonstrating, to a limited group of people under conditions of confidentiality, a partially completed prototype of the TeleMed system executing upon a personal computer.

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4. The software program demonstrated to the limited group of persons consenting to maintain confidentiality was incomplete in a number of ways including, for example, it was not yet capable of generating pre-phrased text from entered code values. However, the patient record generator was capable of generating records containing input text (e.g., dictated text) and text inserted on a patient record in accordance with medical data facts.

5. While demonstrating the prototype at ACEP in 1994, I took specific steps to maintain the confidentiality of the software system currently under development and to prevent others from misappropriating our idea before it was sufficiently ready to be offered to the public. Such steps to maintain confidentiality included physically placing the personal computer executing the prototype program code facing towards the rear of the booth and orienting the display screen to prevent observation by persons who had not consented to maintaining the confidentiality of what they observed during the demonstration of the TeleMed prototype. Persons were not allowed within the booth without first agreeing to maintain the confidentiality of their observations during the demonstration.

6. It has been my understanding, throughout the period of pursuing patents on the inventions disclosed in the present application, that the confidential demonstrations of the prototype software system to a limited group of persons more than one year prior to the filing date of the parent of this application (filed on July 6, 1996) did not affect the patentability of the inventions, and thus the confidential demonstrations at the ACEP Assembly in 1994 (described herein above) are, without question, not material to examination of the present application.

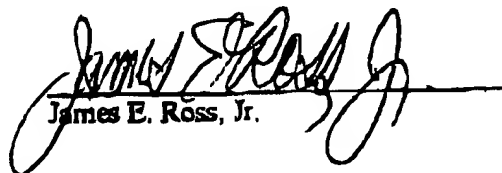
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7. However, in view of a Federal Circuit opinion (*see, GFI Inc. v. Franklin Corp.*, 265 F.3d 1268, 60 U.S.P.Q.2d 1141 (Fed.Cir. 2001)), that has recently been brought to my attention and that encourages placing the decision-making power/responsibility regarding materiality of a reference within the hands of the U.S. Patent and Trademark Office, I submit this declaration of facts relating to the confidential disclosures for consideration by the Examiner.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date:

4/1/2002


James E. Ross, Jr.

201920 (Rev. 11/01)

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TO: EXAMINER PEDRO R, KANOF
GROUP 2164
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C.

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